

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY PULLARO

Appeal No. 2004-0148
Application 09/598,110

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

MAILED

FEB 26 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 2 through 17, which are all of the claims remaining in this application. Claim 1 has been canceled.

Appellant's invention relates to a sports training and conditioning device, and in particular to a device for training

and conditioning in sports which use a handheld implement, such as a bat, a club, a racket, or stick. As set forth on page 1 of the specification (lines 16-27),

[t]he sports training and conditioning device of the present invention is adaptable to virtually any sport that uses a hand-held implement, including baseball, golf, tennis, squash, badminton, hockey, lacrosse, et cetera. Generally, the sports training and conditioning device of the present invention comprises a handle shaped like the grip portion of the implement for the particular sport, for example a baseball bat, having a first and second ends. A weight is mounted on the second end between about six inches and about eighteen inches from the first end of the handle, and more preferably between about eight inches and about thirteen inches from the first end of the grip. The inventor has found that for most sports, this focuses the effect of the device on the user's forearms, and reduces the stress and strain on other parts of the body. The user simply grasps the device as the user would normally grasp the sports implement, and swings the device in a controlled manner just as the user would swing the implement.

Independent claims 2, 15 and 17 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix 1 of appellant's brief (Paper No. 16).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lay	2,884,816	May 5, 1959
Wendt	4,444,396	Apr. 24, 1984
Huffman	5,215,307	Jun. 1, 1993
Hamilton et al. (Hamilton)	5,312,308	May 17, 1994
Breuner	6,138,879	Oct. 31, 2000

(filed Aug. 20, 1998)

In addition to the foregoing prior art references, the examiner has indicated on page 4 of the answer that "OFFICIAL NOTICE was taken in the previous action [Paper No. 12] in which is now admitted prior art." We understand the examiner to be saying that the subject matter which was urged to be subject to Official Notice in Paper No. 12 is now taken to be admitted prior art (hereinafter, APA). See, for example, MPEP § 2144.03(C).

Claims 2, 3, 9 through 13 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lay.

Claims 2 and 17 additionally stand rejected under 35 U.S.C. § 102(b) as being anticipated by Huffman.

Claims 4, 5 and 9 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of APA.

Claims 2 through 5 and 7 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breuner in view of APA.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Breuner in view of Wendt.

Claims 2 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view of Huffman.¹

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we make

¹ According to the examiner's answer, page 3, the prior art rejections based upon Stoneburner ('525) and Hill ('715) made in the last rejection (Paper No. 12) have now been withdrawn. It likewise appears that the rejection of claims 2 through 17 under 35 U.S.C. § 112, second paragraph, made by the examiner in Paper No. 12 has also been withdrawn, since this rejection has not been repeated in the examiner's answer, and thus is not before us on appeal. See Ex parte Emm, 118 USPQ 180 (Bd. App. 1957).

reference to the examiner's answer (Paper No. 17, mailed March 18, 2003) for the reasoning in support of the rejections and to appellant's brief (Paper No. 16, filed January 7, 2003) and reply brief (Paper No. 18, filed May 22, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, this panel of the Board has given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have reached the determinations which follow.

Before turning to the examiner's rejections of claims 2 through 17 on appeal based on prior art, we note that it is an essential prerequisite that the scope and content of the claimed subject matter be fully understood prior to the application of prior art thereto. Accordingly, we direct our attention to appellant's claims on appeal (e.g., independent claims 2, 15 and 17) to derive an understanding of the scope and content thereof.

Independent claims 2, 15 and 17 each include a recitation that the sports training and conditioning device for a sport using a handheld implement having a grip portion of appellant's invention includes "a handle shaped like the grip portion of the implement." Appellant's claims provide no further indication of exactly to what extent the handle of appellant's device is "shaped like" the grip portion of the implement. After reviewing the disclosure of the present application, and remembering that during the prosecution of a patent application claims are given their broadest reasonable interpretation consistent with the specification (See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) and In re Tanaka, 551 F.2d 855, 860, 193 USPQ 138, 141 (CCPA 1977)), we consider that the broadest reasonable meaning of the above-noted terminology, when read consistent with appellant's specification, is that the handle of appellant's claimed device must be so configured in size and shape as to be gripped by the hand or hands of a human being in a manner similar to that which would be used to grip a sports implement. We find no reasonable basis to construe the "shaped like" language of appellant's claims on appeal to require that the handle of appellant's device be identically shaped like a

particular sports implement's handle. In that regard, we note that limitations in the specification will not be read into the claims. See In re Winkhaus, 527 F.2d 637, 639, 188 USPQ 129, 131 (CCPA 1975).

With the above understanding, we turn first to the examiner's rejection of claims 2, 3, 9 through 13 and 17 under 35 U.S.C. § 102(b) based on Lay. The examiner is clearly of the view that the hammer or impact tools disclosed in the Lay patent may be broadly considered to be sport specific training and conditioning devices which comprise a handle including a grip portion "shaped like" the grip portion of a sports implement, and a weight (e.g., head 10) on a second or remote end of the handle, wherein the length of the handle and weight of the head are such (e.g., col. 2, lines 60-67) that the center of mass of the device will be less than about 13 inches from the first end of the handle. Appellant's only argument addressing this rejection is found on page 5 of the brief, and is to the effect that Lay fails to disclose a handle shaped like a grip portion of a sports implement, and that Lay's handle is instead shaped like the handle of a hammer.

From our perspective, the examiner has correctly determined that Lay discloses a device and method as broadly claimed by appellant. In the first place, we note that there are carpentry competitions where a hammer or impact tool like that described in Lay would, at least broadly, be considered to be a "sports implement." In addition, we note that the sport of "Hammer Toss," although not a mainline sport like baseball or tennis, is nonetheless a sport and that the hammers used therein would be "sports implements." Moreover, we observe that one training and conditioning for a carpentry competition like that noted above, would undoubtedly grasp a hammer like that seen in Lay and swing the device to train and condition the arms for such competition. Thus, the hammer of Lay corresponds to the device and method broadly set forth in appellant's claims 2 and 17 on appeal. In that regard, we also observe that the handle of the hammer seen in Lay clearly has a grip portion which is sized and shaped so as to be gripped by the hand or hands of a human being in a manner similar to that which would be used to grip a sports implement, and thus is responsive to the limitation in appellant's claims that the handle of the device be "shaped like" the grip portion of a sports implement.

In light of the foregoing, we will sustain the examiner's rejection of claims 2 and 17 under 35 U.S.C. § 102(b) based on Lay. Since appellant has provided no arguments concerning the separate patentability of claims 3 and 9 through 13 with regard to Lay, we consider that these claims will fall with our determination regarding independent claim 2, from which those claims depend. Thus, the examiner's rejection of dependent claims 3 and 9 through 13 under 35 U.S.C. § 102(b) based on Lay will also be sustained.

We next look to the examiner's rejection of claims 2 and 17 under 35 U.S.C. § 102(b) as being anticipated by Huffman. Huffman is directed to a sport specific training and conditioning device for golf, tennis or baseball, wherein the device comprises a handle including a grip portion "shaped like" the grip portion of a sports implement (col. 1, lines 26-36), and a weight on a second end of the handle remote from the user, wherein the length of the handle and mass of the weights are such (e.g., col. 1, lines 46-51) that the center of mass of the device, at least for some of the devices disclosed in Huffman, will be less than about 13 inches from the first end of the handle. Appellant's argument

here (brief, pages 7-8) generally parallels that made with regard to Lay above, i.e., that the device of Huffman does not have a handle shaped like the grip portion of a sports implement. More particularly, appellant contends that because Huffman has a counterweight at the butt end of the handle, i.e., between the user's hands and body (e.g., as seen in Figs. 1 and 2), as well as at the distal or second end of the handle, that this somehow precludes the handle broadly set forth in claims 2 and 17 on appeal from reading on the handle in Huffman. Appellant also appears to contend that the device of Huffman fails to meet the requirement in claims 2 and 17 that the center of mass be located less than about 13 inches from the first end of the handle.

We find both of these arguments to be unpersuasive of error on the examiner's part. In the first place, as the examiner has noted on page 13 of the answer, the open-ended language of appellant's "comprising" format claims does not in any way preclude an additional weight from being located at the proximal or first end of the handle of the device, so long as the handle has a grip portion "shaped like the grip portion of the

implement," which the devices in Huffman clearly do. As for the second line of argument, it is clear to us that an exercise device as in Huffman with an overall length of 15 inches would inherently have a center of mass located less than about 13 inches from the first end of the handle and, more particularly, because of its counter-weighted construction, the center of mass would be located near the center of the handle, e.g., at about $7\frac{1}{2}$ inches from one end of the device and somewhat less than that from the first end of the handle itself. For the above reasons, we will sustain the examiner's rejection of claims 2 and 17 under 35 U.S.C. § 102(b) as being anticipated by Huffman.²

² In addition to the above comments regarding Huffman, we also make particular note that the device therein may use weights varying between two and six pounds (col. 1, lines 50-51) and that with weights in the range of five to six pounds attached to each end of the handle therein, such device would clearly weigh more than a hand held implement normally used for golf, tennis or baseball. Moreover, as is clear from Figure 10 of Huffman, the handle includes an externally threaded portion and the weights include an internally threaded socket. Huffman, column 1, lines 26-36, also make it clear that the handle of the device therein is shaped like the grip portion of a conventional baseball bat, a conventional tennis racket handle, or a conventional golf club. As a further point, it would appear that a device as seen in Figure 4 of Huffman having an overall length of 15 inches would clearly have a handle which would be less than about 10 inches

(continued...)

With regard to the examiner's rejection of claims 4, 5 and 9 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of APA, we note that appellant has again argued (brief, page 9) that Lay does not disclose a device with a handle shaped like a sports implement. However, for the same reasons already set forth above in treating the examiner's § 102 rejection based on Lay, we find that particular argument unpersuasive here also. Appellant additionally contends, with respect to claim 16 on appeal, that Lay does not teach or suggest a device wherein the center of mass of the device is not located on the handle. Finding no specific response by the examiner to this argument and no reason to find that such a requirement would necessarily be inherent from the teachings in Lay, we will not sustain this rejection. It follows from the foregoing, however, that we will sustain the examiner's rejection of claims 4, 5, 9 through 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of APA.

²(...continued)
long and thus provide an arrangement wherein the center of mass of the weight at the second or distal end of the shaft would be less than about 13 inches from the first end of the handle.

We now look to the examiner's rejection of claims 2 through 5 and 7 through 17 under 35 U.S.C. § 103(a) as being unpatentable Breuner in view of APA. Breuner discloses a mallet tool and method for creating a proper pocket formation in an athletic ball catching glove and, thus, is broadly a sport specific training and conditioning device. The mallet tool of Breuner includes a handle (20), e.g., "in the style and dimension of the handle of a youth baseball bat" (col. 1, lines 60-61), and a head (10) which replicates the size, feel and appearance of a regulation sports ball, e.g., a regulation baseball or regulation softball, and wherein the handle has a length "in the range of 6 inches to 12 inches from where the handle meets the head" (col. 2, lines 47-49). The advantages of and manner of using the tool of Breuner are set forth in column 1, lines 44-53. As shown in Figure 2, one manner of connecting the head (10) to the handle (20) is by having an externally threaded portion on the handle and an internally threaded socket formed in the head to receive and mate with the threaded portion of the handle.

Appellant's argument here (brief, pages 10-11) consists of a general assertion that the device set forth in claims 2 through 5

and 7 through 17 would not have been obvious from Breuner and a reproduction of independent claims 2, 15 and 17, without any specific indication of an error or errors in the rejection, or any explanation of how any limitation in these claims would render the claimed subject matter unobvious over the applied prior art. 37 CFR § 1.192(c)(8)(iv) expressly notes that such a general argument that all limitations are not described in a single reference does not satisfy the requirements of this paragraph. Since we find no specific arguments from appellant concerning this rejection and no other basis to assign error to the examiner's position here, we will sustain this rejection.

In addition to the above determination, we also note that where Breuner's device has a handle with a length in the range of 6-10 inches, the device therein appears to anticipate the device set forth in claims 2, 4, 5, 7, 8, 9, 14, 15 and 17 on appeal. Appellant's argument in the reply brief (page 3) that the regulation baseball/softball serving as the head (10) of Breuner's device does not constitute a weight on the end of the handle as required in the claims on appeal defies logic and is wholly unpersuasive. The ball forming the head (10) of the

mallet tool in Breuner unquestionably has weight and mass and forms a weight on the end of the handle as broadly required in the claims on appeal. We note also that a regulation baseball has a diameter of less than about four inches and therefore a length in the direction of the handle of the device of Breuner of less than about four inches. Accordingly, in addition to the foregoing reason, we will sustain the examiner's rejection of claims 2, 4, 5, 7, 8, 9, 14, 15 and 17 on appeal under 35 U.S.C. § 103(a), noting that anticipation or lack of novelty is the ultimate or epitome of obviousness. See, in this regard, In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Next for our review is the examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Breuner in view of Wendt. Claim 6 adds to parent claim 2 the requirement that the device set forth therein be so constructed that it "weighs more than the hand held implement used in the sport." Recognizing that Breuner does not teach or suggest any such characteristic for the pocket forming mallet tool therein, the examiner looks to Wendt, noting that the weighted golf swing

exercise device of Wendt weighs more than a regulation golf club (col. 2, lines 54-60) and enables the user to strengthen his/her muscles used in the play of golf. From such teachings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to make the ball glove pocket forming mallet of Breuner weigh more than the regulation sporting device, in order to strengthen the user's muscles used for a sport (answer, page 8). Like appellant, given the specific requirements in Breuner concerning the size and shape of the handle therein and the express requirement that the ball attached to the handle be a genuine, regulation baseball or regulation softball, or, at least, replicate the size, weight, feel and appearance of such a ball (col. 3, lines 7-11), we are of the view that there would be no need, and thus no motivation except that derived from impermissible hindsight, for modifying the relatively lightweight pocket forming mallet tool of Breuner in the manner proposed by the examiner based on the weighted golf swing exercise club of Wendt. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or

"template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have determined that the teachings and suggestions found in Breuner and Wendt would not have made the subject matter as a whole of claim 6 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a).

The last of the examiner's rejections for our review is that of claims 2 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view Huffman. In this instance, we share appellant's view (reply brief, page 5) that the examiner's entire premise for this rejection as set forth on page 8 of the answer is flawed. Only in the broadest sense does the forearm exercise device of Hamilton have the same parts and same purpose as appellant's invention. Moreover, absent hindsight, we see no reasonable basis under which "routine optimization of the dimensions and center of mass of the device" seen in Hamilton

would have in any way rendered appellant's claimed subject matter obvious. Likewise, absent the use of impermissible hindsight, we see nothing in Huffman which would have suggested any modification in the exercise device of Hamilton or have provided any motivation to modify the forearm exercise device therein to be like the counter weighted golf, tennis, or baseball training devices of Huffman. If anything, the examiner's explanation on page 13 of the answer appears to urge that it would have been obvious to one of ordinary skill in the art to modify the device of Hamilton to be exactly like the device seen in Huffman. But, we find no basis for any such wholesale reconstruction of the exercise device of Hamilton. Thus, after considering the applied prior art references as a whole, we have concluded that the examiner's rejection of claims 2 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view of Huffman will not be sustained.

To summarize, we have sustained the examiner's rejection of claims 2, 3, 9 through 13 and 17 under 35 U.S.C. § 102(b) as being anticipated by Lay, and that of claims 2 and 17 under

35 U.S.C. § 102(b) as being anticipated by Huffman. We have also sustained the examiner's rejection of claims 4, 5, 9 though 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of APA. However, we did not sustain the examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of APA. We have also sustained the examiner's rejection of claims 2 through 5 and 7 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Breuner in view of APA. But, we did not sustain the examiner's rejections of either claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Breuner in view of Wendt, or claims 2 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view of Huffman. As a result, the decision of the examiner is affirmed-in-part.

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Application 09/598,110

No time period for taking any subsequent action in connection with this appeal may be extended under 35 U.S.C. § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN
Administrative Patent Judge

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